

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants:	David R. Payne, Gerald A. Stangl, Norman E. Stevens, Jr., and Michael F. Gard	Group No.: 3671
Serial No.:	10/617,975	Examiner: Raymond W. Addie
Filed:	July 12, 2003	Att'y Dkt. No. 2380-561
For:	SYSTEM AND METHOD FOR AUTOMATICALLY DRILLING AND BACKREAMING A HORIZONTAL BORE UNDERGROUND	Customer No.: 28839
		Confirmation No.: 4897
		Date: May 27, 2008

**APPELLANTS' REPLY BRIEF**

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## **I. STATUS OF CLAIMS**

Claims 1-3 are withdrawn.

Claims 4-12 are rejected and being appealed.

## **II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. Are claims 4-6 and 12 unpatentable under 35 U.S.C. § 103(a) as rendered obvious by the combination of U.S. Patent No. 5,883,015, issued to Hesse et al. and U.S. Patent No. 6,308,787, issued to Alft?

B. Are claims 7-11 unpatentable under 35 U.S.C. § 103(a) as rendered obvious by the combination of U.S. Patent No. 5,883,015 issued to Hesse et al., U.S. Patent No. 6,308,787 issued to Alft and U.S. Patent No. 5,746,278 issued to Bischel et al., as incorporated by reference in Alft?

### III. ARGUMENT

#### A. The Examiner fails to provide evidence of a *prima facie* case of obviousness of claims 4-6 and 12 in the Answer.

In response to Appellants' Appeal Brief the Examiner has failed to make a *prima facie* case of obviousness to support a rejection of claims 4-6 and 12. In the Appeal Brief, Appellants argued that the combination of Hesse and Alft fails to support a *prima facie* showing of obviousness because they do not enable one skilled in the art to use Appellants' claimed method. See Appeal Brief at 3. The Examiner's Answer has not addressed the enablement issue and fails to refute Appellants' arguments and supporting citations. See Answer at 7. The § 103(a) rejection must fail.

The Alft reference is the only prior art that recognizes a need for automatically reducing a length of drill string. However, Alft only recognizes the problem and provides no enabling solution. See Appeal Brief at 6-7. Appellants have demonstrated that Alft provides significant discussion of other automated functions, but no support for how a "pipe loading controller (141) may be employed to control an automatic rod loader apparatus...." See Appeal Brief at 7. The Examiner has only continued to cite isolated sentences from Alft, without showing any evidence of an enabling disclosure.

To address the lack of enablement, Appellants have also demonstrated that the Rozendall reference, incorporated by reference into Alft and cited by Alft to refer to "an automatic rod loader apparatus", only describes a mechanical rod loader. The Rozendall reference provides a system that merely allows an operator to load a pipe without requiring the operator to physically pick-up and load the pipe onto the machine. See Appeal Brief at 8. What Rozendall does not teach is Appellants' invention – automatically reducing a length of drill string. Thus, Appellants have demonstrated Rozendall does not help to make Alft enabling.

The Examiner's § 103(a) rejection of claims 4-6 and 12 based on Hesse and Alft cannot support a *prima facie* case of obviousness. Nothing in the Answer has provided

additional support for that rejection. Appellants respectfully submit that rejection must be overruled.

**B. Claims 7-11 are patentable over the combination of Hesse, Alft, and Bischel.**

In the Answer, the Examiner has failed to make a *prima facie* case of obviousness to support a rejection of claims 7-11. Appellants demonstrated that the references of Hesse and Alft, when further combined with Bischel et al, still fail to support a *prima facie* showing of obviousness because they do not enable one skilled in the art to use Appellants' claimed method. See Appeal Brief at 8. The Examiner's Answer has not addressed the enablement issue and fails to refute Appellants' arguments and supporting citations. See Answer at 8-9. The § 103(a) rejection must fail.

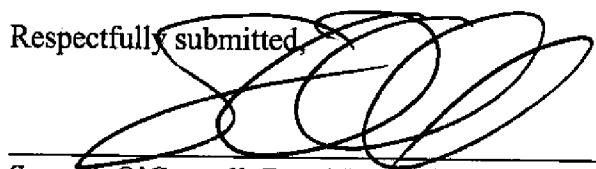
Claims 7-11 depend either directly or indirectly from independent claim 4, which was shown to be patentable over the combination of Hesse and Alft. Appellants demonstrated that neither reference, nor their combination, discloses or enables one of skill in the art to automatically reduce a length of drill string as required by Appellants' claim 4. Bischel does not supply the missing feature. See Appeal Brief at 8-9.

Appellants demonstrated that Bischel, like Alft, does not teach what is needed to automatically reduce a length of drill string – sensors, control logic or the like -- and thus is not enabling. The Examiner has attempted to refute Appellants arguments by stating that the Appellants' claims do not require sensors or control logic, only “that the drill string length be reduced automatically, without regard as to how the “automatically” is performed.” See Answer at 9. But Appellants arguments are clearly intended to demonstrate that its claim language is supported by the disclosure of Appellants' invention, while the cited references are wholly inadequate to provide a teaching for one skilled in the art. Thus, those cited references are not enabling and cannot support a *prima facie* case of obviousness. Claims 7-11, then patentable over the combination of Hesse, Alft, and Bischel. The § 103(a) rejection of claims 7-11 must be overturned.

#### IV. CONCLUSION

Appellants respectfully requests the Board overturn the rejections of claims 4-12, under 35 U.S.C. § 103(a), and that a notice of allowance be issued.

Respectfully submitted,



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